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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,482	07/24/2003	Amit Bagga	502079-A-01-US (Bagga)	1294

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EXAMINER
GELAGAY, SHEWAYE

ART UNIT	PAPER NUMBER
2137	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/626,482	BAGGA ET AL.
	Examiner	**Art Unit**	
	Shewaye Gelagay	2137	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>24 July 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-39</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-39 have been examined.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 16 and 17 recite "quantitatively correlated" and "quantitatively correlated" respectively. However, the applicant in the original application at the time of the filing has not described "qualitatively correlated" and "quantitatively correlated".

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 1-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 24 and 39 recite, "authenticating a user" in

the preamble. Claims 1, 24 and 39 are incomplete because the body of the claim does

not support user authentication instead the body of the claim contains presenting one or

more questions to the user.

6.   Claims 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Claims 16 and 17 recite "qualitatively correlated" and

"quantitatively correlated" respectively. Applicant did not define "qualitatively correlated"

and "quantitatively correlated" distinctly in the claim or in the specification. Both

"qualitatively correlated" and "quantitatively correlated" have to be explicitly defined so

that there would not be any ambiguity.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

8.   Claims 1-39 are rejected under 35 U.S.C. 101 because the claimed invention

lacks patentable utility. Claims 1, 24 and 39 lack usefulness because the body of the

claim does not support authenticating a user as recited in the preamble. The claim

limitations do not produce tangible and useful result because the claim limitations recite

presenting one or more questions to the user without performing user authentication.

Double Patenting

9.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10.   Claims 1, 24 and 39 are provisionally rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims 1, 22

and 32 of copending application number 10/626,483. Although the conflicting claims are

not identical, they are not patentably distinct from each other because claims 1, 22 and

32 of copending application of '483 contain (s) every element of claims 1, 24 and 39 of

the instant application respectively and as such are not patentably distinct from the

copending application.

"A later patent claim is not patentably distinct from an earlier patent claim if the

later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at

896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting

because the claims at issue were obvious over claims in four prior art patents); In re

Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of

obviousness-type double patenting where a patent application claim to a genus is

anticipated by a patent claim to a species within that genus). " ELI LILLY AND

COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the

Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30,

2001).

"Claim 12 and Claim 13 are generic to the species of invention covered by claim

3 or the patent. Thus, the generic invention is **"anticipated"** by the species of the

patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775,

227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure

in the prior art defeats any generic claim) 4 . This court's predecessor has

held that, without a terminal disclaimer, the species claims preclude

issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944,

214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354.

Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly

rejected under the doctrine of obviousness-type double patenting." (In re

Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12.   Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by

Honarvar et al. (hereinafter Honarvar) US Publication Number 2003/0154406.

As per claims 1 and 39:

        Honarvar teaches a method for authenticating a user, comprising:

        obtaining an asserted identity of said user; (page 2, paragraph 28; page 6,

paragraphs 100 and 105)

        obtaining a random subset of questions that said user has previously answered

with a customer verification server; (page 6, paragraphs 104-105; page 9, paragraphs

120 and 122; page 10, paragraphs 126-127) and

        presenting one or more questions to said user from said random subset of

questions until a predefined security threshold is satisfied. (page 22, paragraphs 233-

234, 236, 237)

As per claims 2 and 25:

        Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses wherein said user is directed to said customer verification

server during an enrollment phase. (page 12, paragraph 143)

As per claims 3 and 26:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses wherein said user verification server instructs said user to

select and answer a number of questions that will be used for verification. (page 13,

paragraph 145)

As per claims 4 and 27:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses comprising the step of storing said selected questions at said

user's location. (page 9, paragraph 120)

As per claims 5-6 and 28:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses comprising the step of storing said selected questions at said

customer verification server. (page 22, paragraphs 233, 236, 237)

As per claims 7, 9 and 29:

Honarvar teaches all the·subject matter as discussed above. In addition,

Honarvar further discloses wherein said obtaining step further comprises the step of

obtaining answers from said user for said selected questions. (page 6, paragraph 105)

As per claims 8 and 30:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses wherein said presenting step is performed by an

authentication module. (page 7, paragraphs 112)

As per claims 10 and 31:

Honarvar teaches all the subject matter as discussed above. In addition, Honarvar further discloses wherein said predefined security threshold is based on a sum of security weights of correctly answered questions. (page 22, paragraphs 234)

As per claim 11:

Honarvar teaches all the subject matter as discussed above. In addition, Honarvar further discloses wherein one or more of said questions are directed to an opinion of said user. (page 2, paragraph 27)

As per claim 12:

Honarvar teaches all the subject matter as discussed above. In addition, Honarvar further discloses wherein one or more of said questions are directed to a trivial fact. (page 2, paragraph 25)

As per claim 13:

Honarvar teaches all the subject matter as discussed above. In addition, Honarvar further discloses wherein one or more of said questions are directed to an indirect fact. (page 2, paragraph 24)

As per claims 14-15:

Honarvar teaches all the subject matter as discussed above. In addition, Honarvar further discloses comprising the step of presenting said user with a larger pool of potential questions for selection of one or more questions to answer. (page 6, paragraphs 104-105; page 9, paragraphs 120 and 122; page 10, paragraphs 126-127)

As per claims 16 and 32:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses comprising the step of ensuring that answers to user

selected questions cannot be qualitatively correlated with said user. (page 2, paragraph

20)

As per claims 17 and 33:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses comprising the step of ensuring that answers to user

selected questions cannot be quantitatively correlated with said user. (page 2,

paragraph 20)

As per claims 18 and 34:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses wherein said questions from said random subset of

questions are presented to said user in a random order. (page 25, paragraph 266)

As per claims 19 and 35:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses wherein said questions are presented to said user in the

form of an index identifying each question. (figure 35)

As per claims 20 and 36:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses wherein said user responds to said questions by returning an

index identifying each answer. (page 21, paragraph 228-page 22, paragraph 233)

As per claims 21-22 and 37-38:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses wherein said index identifying each answer can be

aggregated to form a password. (page 21, paragraph 228-page 22, paragraph 233)

As per claim 23:

Honarvar teaches all the subject matter as discussed above. In addition,

Honarvar further discloses comprising the step of storing an indication of said subset of

questions on a device or wallet card or piece of paper associated with said user. (page

7, paragraphs 112)

As per claim 24:

Honarvar teaches an apparatus for authenticating a user, comprising:

a memory; (page 7, paragraph 109) and

at least one processor, coupled to the memory, (page 7, paragraph 109)

operative to:

obtain an asserted identity of said user; (page 2, paragraph 28; page 6,

paragraphs 100 and 105)

obtain a random subset of questions that said user has previously answered with

a customer verification server; (page 6, paragraphs 104-105; page 9, paragraphs 120

and 122; page 10, paragraphs 126-127) and

present one or more questions to said user from said random subset of questions

until a predefined security threshold is satisfied. (page 22, paragraphs 233-234, 236,

237)

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shewaye Gelagay

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER